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IN THE

Supreme Court of the United States

OCTOBER TERM, 1970

NO. ~~1695~~ 70-158

INJECT-O-METER MANUFACTURING COMPANY, INC., *Petitioner*,

v.

NORTH PLAINS FERTILIZER AND CHEMICAL, INC., *Respondent*.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Fifth Circuit

BRIEF FOR RESPONDENT IN OPPOSITION

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Opinions Below

The opinion of the District Court (App. D pp. A21-A30 of Petition) is reported at 308 F. Supp. 538, 164 USPQ 653, (N.D. of Texas, 1970). The opinion of the Court of Appeals for the Fifth Circuit (App. C, pp. A5-A20 of Petition) is reported at ____F.2d____.

Jurisdiction

The jurisdictional requisites are adequately set forth at page 2 of the Petition.

Questions Presented

The two questions presented are stated at page 3 of the Petition.

Statutory Provisions Involved

The pertinent provisions of the Patent Act of July 19, 1952, Title 35 United States Code, §102(b) and §103 are set forth at page 4 of the Petition.

Statement

Respondent-defendant, North Plains Fertilizer and Chemical, Inc., takes issue with the statement of the case by Petitioner-plaintiff, Inject-O-Meter Manufacturing Company, in its petition for a writ of certiorari. Respondent North Plains therefore presents the following factual statement of the case in view of the non-factual argumentative statement presented by Petitioner Inject-O-Meter. Respondent North Plains takes particular issue with Petitioner's supposedly factual statements which are nothing more or less than wholly unsupported charges of false representation and false identification (Petition, page 6). It is believed that such statements are manifestly improper in a supposedly factual statement of the case under Rule 23.

Petitioner Inject-O-Meter brought a first suit against Defendant-respondent, North Plains, in the United States District Court for the Northern District of Texas (Amarillo Division) alleging infringement of its patent 3,326,-

232 involving an apparatus for injecting chemical fertilizers into an irrigation system. Petitioner Inject-O-Meter subsequently brought a second suit in the same court charging Respondent North Plains with infringing its patent 3,375,976 involving a method for the same purpose, e.g., injecting chemical fertilizers into an irrigation system. The two suits were subsequently consolidated.

After discovery by both parties, the District Court granted Respondent's motion for summary judgment and entered judgment dismissing with prejudice Petitioner's complaint in each action.[1] The basis for the judgment was first, that the '232 apparatus patent was not infringed by Respondent; and second, that the '976 process patent was both invalid and not infringed by Respondent. There was no genuine issue as to any material fact underlying this judgment, particularly with respect to the so-called Harrison publication.[2] The District Court found, as a matter of law, that the Harrison publication fully disclosed the patented process:

> "[T]he Court is of the opinion that Plaintiff's process patent is invalid under 35 U.S.C. § 102(b) because its method was taught at least one year prior [to the date of patent application] by the Harrison Publication." 308 F. Supp. 538, 543.

On appeal, the United States Court of Appeals for the Fifth Circuit affirmed the Trial Court's decision of non-infringement of both patents and invalidity of the '976

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1. Inject-O-Meter Mfg. Co. v. North Plains Fertilizer and Chemical, Inc., 308 F.Supp. 538, 543 (N.D. Texas, 1970).

2. Harrison, *Injection of Liquid Fertilizer Materials into Irrigation Systems,* University of Florida Agricultural Extension Service, Circular 276 (1965) (R. 190).

process patent. The Court of Appeals declared an additional basis for the invalidity of the '976 patent under 35 U.S.C. § 103 for the reason that, based on the Harrison publication and the patent in suit, the difference between the patent claims and the prior art would have been obvious at the time the invention was made to a person having ordinary skill in the art.

Argument

I. Petitioner's Question I Erroneously Alleges a Conflict of Decision.

Petitioner presents as its first question upon which review by this Court is sought an allegation that the Court of Appeals for the Fifth Circuit did not apply the requirements laid down in *Graham v. John Deere,* 383 U.S. 1 (1966), and that such failure is in conflict with the requirements of this Court and with certain of the Circuit Courts of Appeal. Quoting from Petitioner's Brief:

> "In declaring the IOM Patent invalid on grounds of being obvious under 35 USC §103, the Court of Appeals for the Fifth Circuit did not apply the requirements laid down by the Supreme Court in Graham v. John Deere, 383 U.S. 1 at 17 (1966):
>
> '. . . the §103 condition . . . lends itself to several basic factual inquiries, under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined . . .' (Petition, p. 7)
>
> * * * *

> "The conflict between the Court of Appeals for the Fifth Circuit and the several Courts of Appeals for the Second Circuit, for the Sixth Circuit, for the Seventh Circuit, and for the Ninth Circuit in the Fifth Circuit Court of Appeals not observing or observing strictly the requirements laid down by the Supreme Court will result in lack of uniformity and definitiveness in determining validity of patents." (Petition, p. 15).

Contrary to Petitioner's assertions, the opinion rendered by the Court of Appeals in this case amply demonstrates that Court's cognizance of and adherence to the requirements laid down by this Court in *Graham v. John Deere.* The Court of Appeals initiated its inquiry into the obviousness of the subject patent by quoting the very pronouncements of this Court in *Graham v. John Deere* which Petitioner asserts were not complied with. Quoting from the Court of Appeals' decision as reproduced in the Appendix to Petitioner's Brief:

> " 'What is obvious is not a question upon which there is likely to be uniformity of thought in every given factual context. The difficulties, however, are comparable to those encountered daily by the courts in such frames of reference as negligence and scienter, and should be amenable to a case-by-case development.'
>
> "Accordingly, the issue of obviousness is a question of law to be determined after examination of the following factual considerations:
>
> 'the scope and content of the prior art . . . .; differences between the prior art and the claims at issue . . .; and the level of ordinary skill in the pertinent art.' "
>
> (Petition, pp. A9 and A10)

The Court of Appeals then proceeded to examine the indicated "factual considerations" based upon the undisputed disclosures of the prior art of record and of the patent in suit.

> "(a) *The Prior Art.* Our examination of the prior art need go no further than a 1965 publication by the University of Florida Agricultural Extension Service. That pamphlet contains a collection of brief descriptions of methods for injecting liquid fertilizer into irrigation lines."
>
> * * * *
>
> "(b) *Appellant's Process.* IOM's patent prescribes an improved process for implementing the prior art described above by making the level of application of fertilizer more easily regulatable and uniform despite fluctuations in the flow of water through the main discharge line."
>
> * * * *
>
> "(c) *Difference Between Prior Art and Appellant's Process.* Practically speaking, then, the patent calls for the substitution of an adjustable 'throttle valve' for the above discussed cut-off valve, and the conscious manipulation of the relationship of pressures in the injection line on either side of the throttle valve and in the irrigation line itself."
>
> * * * *
>
> "In terms of methodology, the only discernible difference between the patented process and the prior art are embodied in Claims 1(b) and 2; absent these claims the process would have been entirely disclosed by the University of Florida circular." (Petition, pp. A10-A13).

Thus, it is apparent that the Court of Appeals made full and detailed inquiry into the scope and content of

the prior art and the differences between the prior art and the claims at issue, and labeled its factual considerations accordingly. Nor would it appear that Petitioner, despite the broad allegations of its Brief, is contesting either the existence or accuracy of the Court's determination on these first two parts of the three-part Graham test. Rather, the Petitioner's only specific complaint with regard to the obviousness determination is an allegation that the Court of Appeals in its opinion failed to include a corresponding finding regarding the level of ordinary skill in the pertinent art. (Petitioner's Brief p. 3). Contrary to Petitioner's allegation, it is perfectly clear from the opinion itself that the Court determined the level of ordinary skill in the art:

> "(d) *Obviousness.* For reasons to be discussed below, it is our conclusion that the difference between these claims and the prior art 'would have been obvious at the time the invention was made to a person having ordinary skill in the art.'
>
> "As we perceive appellant's patent, its two principal characteristics are that the flow of fertilizer is (1) precisely regulatable and (2) relatively independent of variations in the flow of water through the main line. The problems solved by these improvements were conspicuous in the prior art. To recognize them was in no way inventive. Once the first need—for a regulatable system—is recognized, the solution reached in the patent—an adjustable orifice—is readily apparent. The second need—for an injection system which is insensitive to the irrigation flow rate—manifestly depends on the interrelationship of pressure levels within the system. This, in turn, would readily suggest that the problem could be solved by experimental manipulation of the pressure levels until a satisfactory relationship

> of pressures was delivered. We need go no further into detail or speculation to describe the mechanical trial and error process that would logically follow. Manipulation of the relationship of the size and speed of the pump and of the relative size of the various pipe lines to the size of the opening in the throttle valve would inevitably lead to IOM's solution. Simply by using a larger-than-necessary pump and throttling down the adjustable valve, the process of the patent could be duplicated in all of its vital elements by one of ordinary skill in the art." (Petition, p. A14).

Thus, the Court of Appeals clearly concluded on the basis of undisputed evidence before it, and before the trial court, that the problems solved by Petitioner's process patent were readily apparent in the prior art, and that any person ordinarily skilled in the art, if presented with these problems, could readily, and without exercise of inventive skill, arrive at the solution embodied in Petitioner's patent.

> " 'Such advance in the art, if advance there was, merely resulted from that type of activity reasonable to be expected of those mechanically skilled in the applicable art.'
>
> "The process 976 patent is invalid by virtue of its obviousness. We make this determination as a matter of law based on evidence which convinces us beyond a reasonable doubt that the statutory presumption of validity of issued patents should fall." (Petition, p. A15).

In summary, the Court of Appeals for the Fifth Circuit, in its opinion, clearly recognized and enunciated the *Graham v. John Deere* test, it then made detailed examinations into each of the "factual considerations" based

on undisputed factual materials in evidence before it and about which there was no genuine issue as to any material fact, and concluded as a matter of law that the subject patent was invalid for obviousness. Therefore, the obligation placed upon the Court by virtue of the decision in *Graham v. John Deere* has been fully discharged.

II. Petitioner's Question II Raises No Important Question of Federal Law.

In his second question, Petitioner challenges the Trial Court's determination, affirmed by the Court of Appeals, that the process patent was invalid under 35 U.S.C. §102(b) for the reason that

> "(b) The invention was patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States."

The Trial Court, in its Memorandum Opinion (Petition, pp. A21-A30), found that a 1965 publication (Harrison publication) fully disclosed the method of plaintiff's patent,

> "[T]he Court is of the opinion that Plaintiff's process patent is invalid under 35 U.S.C. §102(b) because its method was taught at least one year prior by the Harrison publication." (Petition, p. A30).

and therefore invalidated the patent.

While Petitioner urges now, as indeed it urged before the Trial Court and the Court of Appeals, that the Harrison publication does not teach its process, this is no more than a request for this Court to re-examine facts already considered by two previous courts. The opinion

of the Court of Appeals was primarily directed at the additional basis for invalidity under §103, Obviousness. However, the Court of Appeals did consider and quote from the same Harrison publication, and concluded that the Trial Court's determination of invalidity under §102 (b) should stand. The facts supporting § 102 (b) invalidity, have been twice considered with the same result. Petitioner's request that this Court should again consider those same ultimate facts appears unwarranted and wholly fails to come within any of the traditional reasons, as stated in Supreme Court Rule 19, for which writs of certiorari are granted.

CONCLUSION

For the reasons stated, Petitioner's two questions on which review is sought are ill-founded. As shown by the opinion of the Court of Appeals for the Fifth Circuit, that Court is fully cognizant of this Court's decision in *Graham v. John Deere* and has fully implemented that decision in the present case, so that the decision in the present case is not in conflict with any decision of this Court, or of any Court of Appeals.

Petitioner's second question presents no more than a request for a factual determination by this Court of what is shown in a particular prior art publication, and therefore does not comprise subject matter of such special or important nature as to justify review by this Court.

Additionally, Respondent would point out that Petitioner has not appealed from the Court of Appeals' affirmance of the Trial Court's holding of noninfringement of the patents in suit, and therefore, as between the instant

parties, the ultimate result of the present litigation is already determined and will remain unchanged regardless of further proceedings.

It is, therefore, requested that Petitioner's Petition for a Writ of Certiorari to the United States Court of Appeals for the Fifth Circuit be denied.

Respectfully submitted,

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